UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,118	06/07/2001	Kulvir Singh Bhogal	AUS920010352US1	1243

70426 7590 11/15/2011

IBM AUSTIN IPLAW (DG)
C/O DELIZIO GILLIAM, PLLC
15201 MASON ROAD, SUITE 1000-312
CYPRESS, TX 77433

EXAMINER	
SWEARINGEN, JEFFREY R	
ART UNIT	**PAPER NUMBER**
2445	

NOTIFICATION DATE	DELIVERY MODE
11/15/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@DELIZIOGILLIAM.COM
USPTO2@DELIZIOGILLIAM.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KULVIR SINGH BHOGAL, ISHMAEL NIZAMUDEEN,
and JAVID JAMEOSSANAIE

Appeal 2009-012718
Application 09/876,118
Technology Center 2400

Before ERIC S. FRAHM, KRISTEN L. DROESCH,
and BRUCE R. WINSOR, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-12, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

STATEMENT OF THE CASE

Appellants' invention relates to delivery of Web content within the body section of an electronic e-mail message, (Spec. 2). Claim 1, which is illustrative of the invention, reads as follows:

> 1. In a distributed computer system including a server and a client, the server including a message store, a method for delivering Web content within a body section of electronic mail messages comprising:
>
> receiving at a server, at least one mail message containing an embedded hyperlink;
>
> downloading Web content associated with the hyperlink into the message store at the server; and
>
> transmitting the mail message and the corresponding Web content for display at the client.

Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as anticipated by Beck (US 5,903,723; May 11, 1999).

Rather than repeat the arguments here, we make reference to the Briefs (App. Br. filed Nov. 1, 2005; 1st Supp. Br. filed June 7, 2006; 2nd Supp. Br. filed Dec. 3, 2007) and the Answer (mailed Mar. 11, 2008)[1] for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this

[1] The Examiner's Answers mailed Jan. 11, 2006, Sept. 20, 2007, and Feb. 6, 2008, have not been considered as they are deemed to have been superseded and replaced by the Answer mailed Mar. 11, 2008.

decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues raised by Appellants' contentions are:

Does Beck disclose "downloading Web content associated with the hyperlink into the message store at the server[,] and transmitting the mail message and the corresponding Web content for display at the client," as recited in claim 1?

Does Beck disclose "parsing the hyperlink when a tagged message is sent to the client," as recited in claim 2?

Does Beck disclose "determining whether the Web content exceeds a predetermined size; and in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds the predetermined size, at the server," as recited in claim 3?

Does Beck disclose "determining whether the client has a preset time for downloading messages containing Web content[,] and in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached," as recited in claim 4?

ANALYSIS

Claim 1

Appellants contend that Beck does not disclose "downloading Web content associated with the hyperlink into the message store at the server,"

because "Beck does not teach resolving a Web hyperlink and downloading the content referenced," (App. Br. 8). Appellants further contend "Beck does not teach or suggest ['transmitting the mail message and the corresponding Web content for display at the client'], and, in fact, teaches against the *combined transmission* of the message and [Web] content," (App. Br. 9) (emphasis added). The Examiner responds that Appellants' "argument of how the hyperlink was resolved and the content transmitted is contrary to the claim language" (Ans. 7). In other words, Appellants are arguing limitations not found in the claim.

We agree with the Examiner. Although, in giving the verbiage of a claim its broadest reasonable meaning, the USPTO takes into account whatever enlightenment may be afforded by the Specification, *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997), "it is important not to import into a claim limitations that are not part of the claim." *SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). We have reviewed the Examiner's findings (Ans. 5) and explanations (Ans. 6-7), find them to be reasonable, and adopt them as our own.

For emphasis only, we note that the claim does not recite when or how the Web content is downloaded, does not recite that the mail message and corresponding Web content are transmitted together, and does not preclude intervening steps between the transmission of the message and the transmission of the Web content. We note, for further emphasis, that the examples of Web content found in the Specification (Spec. 4:9-11; *see* App. Br. 8) do not preclude Beck's attachments from being "Web content." We find that Beck discloses that attachment 611, located on WWW server 610,

connected to the internet 601, and addressable by URL 627, is "Web content" (Beck Fig. 6).

Therefore, we sustain the rejection of claim 1 and of claims 5 and 9, which were argued together with claim 1 (App. Br. 9).

Claim 2

The Examiner finds that Beck discloses "parsing the hyperlink *when* a tagged message is sent to the client" (emphasis added), as recited in claim 2 on appeal, at column 5, line 34 - column 6, line 12 and column 8, line 56 – column 9, line 16, (Ans. 6). The Examiner further explains "Beck disclosed a local computer reading a pointer, or attachment reference, or hyperlink, which allowed a computer to access the stored content. See Beck, column 5, lines 11-33." (Ans. 7). Appellants contend "[t]hese sections of Beck describe removal of attachments and replacing with an attachment reference as described above. There is no teaching of sending the Web content with the e-mail." (App. Br. 7).

We agree with Appellants. Here the claim recites that the hyperlink is parsed *when* (i.e., at the same time as) the tagged message is sent to the client. We find that the portions of Beck (col. 5, l. 11 – col. 6, l. 12; col. 8, l. 56 – col. 9, l. 16) referenced by the Examiner disclose that an attachment (i.e., Web content) is retrieved (i.e., the hyperlink is parsed) when (and if) desired by the recipient of the message (i.e., the user of the client), not when the message is sent to the client (*see e.g.,* Beck col. 5, ll. 27-33).

Accordingly, we do not sustain the rejection of claim 2, or of claims 6 and 10, which were argued together with claim 2 (App. Br. 10), and include the same recitation that we find not disclosed by Beck.

Claim 3

Appellants contend:

> the Examiner has failed to point out any description in Beck that teaches testing the size of Web content accessed using a hyperlink in a[n] e-mail message and. in response to the test, compressing the content before storing it on the server. The Examiner's reference to Beck, col. 6, lines 38-60 is inapplicable. That section of Beck teaches compression of an attachment before creating a reference and not after such a reference is resolved.

(App. Br. 8). The Examiner responds by referring back to the explanations provided for claim 1 (Ans. 7), i.e., that Appellants are arguing limitations ("resolving" of the hyperlink) not recited in the claim. *See SuperGuide*, 358 F.3d at 875.

We agree with the Examiner. We have reviewed the Examiner's finding (Ans. 6) and explanations (Ans. 7), find them to be reasonable, and adopt them as our own. For emphasis only, we find that claim 3 does not recite when the step of determining whether the Web content exceeds a predetermined size is performed or when (other than at some time subsequent to the determining step) the Web content is compressed.

Therefore, we sustain the rejection of claim 3 and of claims 7 and 11, which were argued together with claim 3 (App. Br. 10).

Claim 4

The Examiner finds that Beck discloses "determining whether the client has a preset time for downloading messages containing Web content; and in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached," as recited in claim 4, at column 13, lines 31-39,

(Ans. 6, 8). Appellants contend "[Beck's] server allows the recipient to check mail at 'a later time' but does not teach or suggest the claimed steps of determining whether the user has set a predetermined time for message download and caching the messages and Web content at the server until that time" (App. Br. 9).

We agree with Appellants for the reasons set forth by Appellants (*id.*). Accordingly, we do not sustain the rejection of claim 4, or of claims 8 and 12, which were argued together with claim 4 (App. Br. 11), and contain the same recitation that we find not disclosed by Beck.

DECISION

The decision of the Examiner to reject claims 1, 3, 5, 7, 9 and 11 is affirmed. The decision of the Examiner to reject claims 2, 4, 6, 8, 10 and 12 is reversed.[2]

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED-IN-PART

[2] The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. In the event of further prosecution we leave it to the instant Examiner to determine the appropriateness of any further rejections of claims 5-12 under 35 U.S.C. § 112, second paragraph. *See* Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, Part 1.III.C, 76 Fed.Reg. 7162, 7167-68 (Feb. 9, 2011).

ke